

## REMARKS

Claims 1-17 are now pending. In the Final Rejection, the Examiner requested that Applicants advise the Examiner of co-pending applications or other references which are material to the patentability of the application. Applicants note that the Information Disclosure Statements of record in this case provide all information known by Applicants to be material to the examination. Additionally, Applicants note that the references "cited" in the specification are referenced in order to define the state of the art.

In the Office Action, the Examiner maintains her previous rejections of the claims under 35 U.S.C. § 112, first paragraph. While Applicants continue to disagree with the Examiner's § 112 rejection, Applicants have substantially amended claim 1 for the Examiner's consideration. Applicants submit that the present specification, along with the five (5) Declarations previously submitted pursuant to 37 C.F.R. § 1.132, clearly and adequately enable one ordinary skilled in the art how to practice the full scope of the claimed invention.

As the Examiner will note, the herbicidal composition currently claimed in amended claim 1 is comprised of a compound of formula I and at least one co-herbicide selected from 29 specific co-herbicides. The Examiner may appreciate that amended claim 1 is significantly narrower in scope than as originally filed. Indeed, the compound of formula (I) as now recited has the general structure represented as (Ie) in Applicants' specification. Applicants' specification provides numerous examples of compounds having the general structure of formula (Ie). These examples can be found in Applicants' specification, for example, in Table 1 located on pages 25-30.<sup>1</sup>

The twenty-nine (29) co-herbicides remaining in amended claim 1, and the increased herbicidal action exhibited by these co-herbicides in combination with the selected compound of formula (I), is clearly enabled by Applicants' specification. Applicants have at a minimum illustrated a representative sample of the selective herbicidal action of the compound of formula I and each of the twenty-nine (29) herbicides. Reference is made to pages 39-45 of the present specification, as well as the five (5) 1.132 Declarations of Jutta Glock submitted in response to the Office Action dated February 23, 2005. Particularly, the specification and the Declarations demonstrate the herbicidal action of over 30 different compositions comprised of a selected compound of formula (I) and a selected co-herbicide. Specifically, the Examiner's attention is directed to all five (5) of the 1.132 Glock Declarations and pages 40-44 of the present specification wherein the synergism is demonstrated between a selected compound of formula (Ie) and the following members of the nine (29) co-herbicides listed below:

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<sup>1</sup> The page numbers referenced correlate to the pagination of WO 01/17351

- *Clodinafop-P-propargyl*
- *Fenoxaprop-ethyl*
- *Tralkoxydim*
- *Triasulfuron*
- *Amidosulfuron*
- *Tribenuron*
- *Idosulfuron*
- *Thifensulfuron-methyl*
- *Metsulfuron*
- *Flupyrsulfuron*
- *Sulfosulfuron*
- *Mecoprop*
- *Fluroxypyr*
- *MCPA*
- *2,4-D ester*
- *2,4-D amine*
- *Triallate*
- *Prosulfocarb*
- *Dicamba*
- *Diflufenican*
- *Bromoxynil*
- *loxynil*
- *Florasulam*
- *Flucarbazone*
- *Propoxycarbazone*
- *Metosulam*

Applicants respectfully submit that they have provided more than a sufficient number of representative examples such that one of skill in the art would expect that any select compound of formula (I) and second herbicide as claimed would be expected to perform in the same manner without undue experimentation. To argue the contrary will require more than a general allegation that Applicants' disclosure would have not taught one skilled in the art how to make and use the full scope of the claimed invention. Indeed, as provided in MPEP § 2164.03. "[p]roof of enablement will be required for other members of the claimed genus *only where adequate reasons* are advanced by the examiner to establish that a person skilled in the art could not use the genus as a *whole* without undue experimentation." (MPEP § 2164.03, p. 2100-196).

The Examiner's enablement rejection seems to focus on the breadth of the compound of formula I since, "compound of formula I itself include very large number of compounds due to variety of substituents defined by G, R<sup>1</sup> and R<sup>2</sup>." (Office Action, page 4)

Applicants note that, as currently amended, the variants for formula I are quite limited and include only three (3) functional groups defining the G substituent, i.e., hydrogen, carboxylic acids and carboxylic esters, while the definitions for R<sup>1</sup> and R<sup>2</sup> are limited to only alkyl, alkyloxy, alkynyl, halogenated alkyl and halogenated alkyloxy. Given the teachings of the specification and the many, many compounds exemplified in the table at pages 25-30, Applicants respectfully submit that the specification exemplifies a representative sample of these compounds such that one of ordinary skill in the art would be able to make and use all compounds embraced by the claims without undue experimentation. The Examiner has provided nothing more than mere allegations that undue

experimentation is necessary. Absent concrete examples of compounds falling within the claims that are not enabled, Applicants respectfully submit that the Examiner has failed to establish lack of enablement. Respectfully, Applicants request withdrawal of the rejection under 35 USC § 112.

Finally, with respect to the Examiner's § 103(a) rejections of the claims, Applicants note that the Examiner has previously stated that arguments related to the Muhlebach reference, the primary reference in this case, presented in the Response filed on January 4, 2005, were **persuasive**; the Examiner then **withdrew the rejection** over the same primary reference. See specifically page 2 of the Office Action mailed on August 11, 2005. In Applicants' response dated January 4, 2005, Applicants presented the following arguments:

Furthermore, with reference to the Muhlebach et al. citation, Muhlebach et. al (WO 99/47525, US 6,410,480) is **NOT** prior art under 103(a)/102(e), (f), or (g). The WO 99/47525 application was filed March 3, 1999; and is not available as prior art under the revisions of the American Inventors Protection Act of 1999. International filing dates prior to November 29, 2000 cannot be used under 102(e) for prior art purposes. In fact, publications of international applications filed before November 29, 2000 do not have a 102(e) date at all.

Under pre-AIPA law which applies in this case, WO 99/47525 has a publication date of September 23, 1999, which is after the filing date of the present application. The present application has an effective filing date of September 7, 1999 (i.e. before the publication of the cited reference). Response, page 2.

Applicants further note that the Muhlebach reference at issue, US 6410480, is the corresponding US Patent to the now-applied WO99/47525. See specifically page 1 of the '480 patent, paragraph (87). Applicants do not understand why the same document, with the same effective date under 35 USC §102, was specifically overcome in August 2005 but is now relevant and applied in a § 103 rejection?

Applicants respectfully reiterate the argument presented above that the primary reference, WO99/47525 (the equivalent of US 6410480) **does not qualify as prior art** in this case. As the primary reference cannot be asserted against the present claims, the rejection of claims 1-7, as set forth on pages 13-15, cannot be maintained.

Similarly, with respect to the rejection of claims 1-16 as being unpatentable over Muhlebach (presumably WO99/47525, which is the equivalent to US 6410480) in view of Hazen, Applicants respectfully request withdrawal of the rejection. As the Muhlebach reference does not qualify as prior art, the Examiner has not shown that Hazen alone teaches or suggests the present invention at the time the invention was made. Specifically, Hazen fails to teach the specific compounds of

formula I, and it fails to teach such compounds in combination with co-herbicides. Accordingly, Applicants request withdrawal of the rejection.

Based upon the foregoing then, Applicants submit that the pending claims are in condition for allowance and the Examiner is courteously solicited to pass this application on to allowance. No other fees are believed to be payable at this time. However, the Commissioner is authorized to debit any applicable fees from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

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